For the record, the applicant respectfully disagrees that the structure as now set forth no longer includes any benefit of equivalent structure. Clearly, nothing has happened to still equivalency.

More importantly, the applicant respectfully submits that the examiner has erred in concluding that the applicant has effectively *canceled* a claim to any particular subject matter within the meaning of *Ball*. The applicant did not *cancel* any subject matter during prosecution of the original patent. The only alteration made to the independent claim was to insert the word "and" and this was done, as noted in the remarks section at the time of making the insertion, "to correct grammatical errors."

Further, while the applicant did distinguish this claim during prosecution from a single prior art reference by noting that the prior art reference failed to disclose at least two elements of claim 1, these being the drive unit and the means for preventing the garage door from opening, merely pointing out these two differences is not sufficient to trigger the recapture rule.

In *Hester Industries Inc. v. Stein Inc.*, 46 U.S.P.Q.2d 1641. (C.A.F.C. 1998), the United States Court of Appeals for the Federal Circuit uniquely dealt with a situation where the recapture rule was applied to an applicant who had not affirmatively canceled subject matter from a claim. In that case, the Court determined that the recapture rule should nevertheless be applied against an applicant notwithstanding the absence of affirmative cancellations because that particular applicant had presented repeated, sustained, and emphasized reliance upon the importance of some specific limitations in his claims. In particular, the applicant in *Hester* had asserted and specifically insisted "no less than 27 places in six papers submitted to the Patent Office" that one particular limitation was important and "no less than 15 places in at least five papers" that another limitation was equally important. This applicant's long term and consistent insistence upon the "critical" and "material" nature of these limitations, coupled with the sheer weight of the applicant's numerously repeated arguments and representations, were deemed sufficient to invoke the recapture rule notwithstanding the lack of a more traditional direct cancellation of subject matter.

The present situation presents diametrically opposing facts. In the present application, the applicant only presented his position regarding the limitation in question a single time. Furthermore, when presenting this position, the applicant preceded that presentation with this statement:

> "The device of Ball et al. fails to disclose *at least* two elements of claim 1." [Emphasis supplied.]

This characterizing statement clearly indicates that the applicant anticipated that other limitations also existed that would serve to distinguish the claim from the prior art reference such that allowability did not ultimately hinge only upon the two elements that were then specifically set forth. This case does not present a situation where an applicant has clearly abandoned a claim to particular subject matter through argument - in fact it presents instead an opposite scenario.

The applicant therefore respectfully submits that no subject matter was "canceled" sufficient to justify imposition of the recapture rule in this application.

In addition, the applicant wishes to respectfully point out that the examiner seems to have disregarded the fact that both of the two new independent claims are also broader than the independent claim that appears in the original patent in another regard. Specifically, both new claims do not include the following recitation that also appears in claim 1 of the issued patent:

> "and means for engaging the jack shaft to prevent further jack shaft rotation when the pull-up cable becomes slack."

This limitation was not the subject of any discussion or activity whatsoever during prosecution of the original patent application.

3. There being no other rejection of the claims, the applicant respectfully submits that these claims are in suitable condition to support allowance. Early notification of allowability is respectfully requested. Should the examiner have any questions, applicant's counsel may be contacted at 312 577-7000.

Respectfully submitted,

Steven G. Parmelee
Registration No. 28,790

Date: October 12, 2001

FITCH, EVEN, TABIN & FLANNERY
120 S. LaSalle St., Suite 1600
Chicago, Illinois 60603
Telephone: (312) 577-7000
Facsimile: (312) 577-7007